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Paper No. 24.

PAT. & T. M. OFFICE
BOARD OF APPEALS

Appeal No. 588-11

DFB

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Robert L. Lundak

- - -

Application for Patent filed March 26, 1981, Serial No.
247,656. High Fusion Frequency Fusible Lymphoblastoid Cell Line.

Bertram I. Rowland et al. for appellant.

Primary Examiner - Thomas G. Wiseman.
Examiner - John E. Tarcza.

Before Mattern, Serota, Sturtevant, Henon, Milestone, Merker,
Blech, Katz, Goldstein, Pellman, Seidleck, Lovell, Bjorge,
McKelvey, Winters, Steiner, Goolkasian and Rzucidlo,
Examiners-in-Chief.

Pellman, Examiner-in-Chief.

REQUEST FOR RECONSIDERATION

Appellant has requested us to reconsider our decision
mailed August 21, 1984, in which we affirmed the examiner's
rejection of claims 1 and 2, the only claims in the application.

In his request for reconsideration, appellant presents arguments on three points. The first concerns the issue of the term of years for the deposit of the cell line to which the claims are directed. The second involves the concurring opinions in this case and the third argues that a deposit of a biological specimen need not be made on or before the filing date of a U.S. application.

With respect to the first point, appellant urges that, while the original deposit at the A.T.C.C. was for 20 years, at the time of the present appeal, the deposit complied with the requirements of the Budapest Treaty. In support of his position, appellant has presented a declaration by Bobbie A. Brandon, the head of the patent depository at the A.T.C.C. The declaration confirms that the deposit is being maintained for 30 years from the date of deposit and not less than 5 years from the last request.

Evidence, including declarations, is ordinarily not considered by this board in connection with requests for reconsideration. However, when the declaration is directed to factual assumptions in a decision, it is appropriate to consider such evidence. See In re Bulina, 53 CCPA 1275, 362 F.2d 555, 150 USPQ 110 (1966). Accordingly, we have reviewed the Brandon declaration and, in view thereof, we find no further reason to discuss the first issue. Consequently, the term of years of appellant's contractual obligation with the A.T.C.C. is no longer an issue in this appeal.

Appellant's second argument is addressed to the proposed new ground of rejection under 37 CFR 1.196(b) in each of the concurring opinions. However, since only a minority of this panel subscribed to said new grounds of rejection, there is no purpose

to be gained by discussing the merits or demerits of appellant's position.

We have considered whether we made a new ground of rejection by our observation at page seven of our decision, that appellant had not established that the depository discussed in his brief met the minimum qualifications for recognition by the Patent and Trademark Office. We are still of the opinion that our observation did not constitute a new ground of rejection. Appellant, himself, first raised the question by alleging that the laboratories should be considered as a depository. By bringing to appellant's attention the inadequacy of the record to support this argument, we did not change the thrust of the examiner's position and did not deprive appellant of his legal rights. Compare In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976).

Appellant's third argument concerns the principal issue in this appeal - appellant's contention that a deposit is not required at the time of filing, but may be required at some future date. Initially, appellant correctly observes that the requirements of the Budapest Treaty cannot be inconsistent with the patent laws of the United States. This, we acknowledge. However, we cited the provisions of said Treaty merely to show that the interpretation of 35 USC 112 as requiring a deposit at the time of filing is consistent with international practices. The Treaty does not mandate that the United States must require such a deposit, but it clearly supports the reasonableness of the Patent and Trademark Office's requirement.

Appellant speculates that if a deposit is made, which is later found to be unnecessary, the public will obtain an unwarranted benefit. We disagree. The question of restricted

access to a deposited microorganism during the pendency of the application in the Patent and Trademark Office was considered by the court in In re Argoudelis and in Feldman v. Aunstrup, both cited in our decision. By the expedients discussed by the court in the two noted decisions, appellant is well able to protect his invention against disclosure in the event that a patent is not granted.

At page 8 of the request, appellant sets forth the premise "[i]t would seem more appropriate that the applicant should be allowed to raise the issue with the Primary Examiner and have the issue of the requirement of a deposit resolved prior to requiring the deposit." We believe the deposit is necessary. However, in any event, as previously noted, appellant may file his deposit with restricted access and then discuss the issue of the requirement with the primary examiner.

The last point we wish to discuss is appellant's contention that, after an application is filed, continuing research may show that one of the sister clones is far superior to the original clones which were screened. Appellant then suggests that it would be in the interest of the public that an applicant deposit the best clone, which would not be new matter, since it existed at the time of the filing date. Not only do we take issue with appellant's position, but we consider such reasoning to be supportive of the conclusion set forth in the majority opinion herein. Improvements later found in an originally filed application may be protected and disclosed to the public by means of one or more continuation-in-part applications. This situation would be analogous to an applicant finding that one compound, out of a large genus previously claimed, exhibits patentably distinctive

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properties over the class as a whole. By the expedient of filing such a continuing application, appellant would be able to obtain protection on the most valuable member of his clones. Accordingly, we do not find this reasoning to be inconsistent with our holding that a deposit is necessary as of the filing date of the application.


Contrary to appellant's arguments, we are convinced that the purpose of the statute requiring a full disclosure of the invention in an application, at the time of filing, is not to establish that an applicant is in a position to provide an enabling disclosure at some future date. Instead, the purpose is to place such enabling disclosure on file in the Patent Office. As we explained in our decision, the deposit of the organism in a recognized depository was and is a device arrived at by the Patent and Trademark Office for the benefit of the public, whereby the statutory purpose of enablement may be fulfilled even where a microorganism is a critical feature of an invention.


We have reconsidered our decision to the extent indicated, but aside from the modification previously noted, we decline to make any further changes therein.


GRANTED-IN-PART

Fred C. Mattern, Jr.
Fred C. Mattern, Jr.
Examiner-in-Chief)
)
)
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Sturtevant
Brereton Sturtevant)
Examiner-in-Chief)

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Paul J. Henon, Jr.
Examiner-in-Chief


Gordon K. Milestone
Examiner-in-Chief

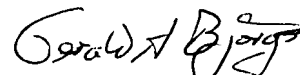

Evelyn K. Merker
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Melvin Goldstein
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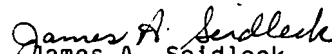
Rzucidlo, Examiner-in-Chief, Blech, Seidleck and Goolkasian, Examiners-in-Chief, Specially Responding To Request For Reconsideration:

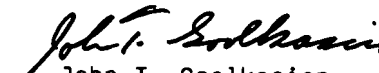
Appellant has not requested reconsideration of any of the reasoning or the conclusion of our concurring opinion as to the time of deposition of a microorganism but rather has asked that we either accept certain proffered declarations and make them part of the record or remand this application to the examiner for his evaluation of this newly submitted evidence. Under the provisions of the rules, we cannot grant appellant's request.


While we have delineated our decision and supporting opinion to constitute a new rejection, the majority opinion has not done so and, hence, new evidence at this point cannot be entered or considered by us.

Appellant's request directed to the members joining in the concurring opinion authored by Examiner-in-Chief Rzucidlo is denied.


Samuel H. Blech
Examiner-in-Chief


James A. Seidleck
Examiner-in-Chief


John T. Goolkasian
Examiner-in-Chief


Eugene C. Rzucidlo
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